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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,965	03/30/2004	Shinichiro Fukushima	500.43711X00	2890
20457	7590	11/02/2006	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			SONG, JASMINE	
			ART UNIT	PAPER NUMBER
			2188	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,965

Applicant(s)

FUKUSHIMA ET AL.

Examiner

Jasmine Song

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/30/04 & 12/20/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Detailed Action

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. For Example:

In the specification, page 10, lines 8, "the IC card 4" should be changed to – the IC card 104--.

Page 10, lines 19, "the management unit 101" should be changed to –the management unit 102--.

Drawings

2. The drawings filed on 03/30/2004 have been approved by the Examiner.

Oath/Declaration

3. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. 1.63.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 03/30/2004, 12/20/2004 and 08/1/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 and 8-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Arisawa et al., US 2004/0035930 A1.

Regarding claim 1, Arisawa teaches a portable terminal comprising:

an IC card mounting module to mount selected one of a non-contact and a non-contact/contact IC card (Fig.1 or 2 or Fig.5);

a memory module (a memory 104 as shown in Fig.5) to store the conditions for the corresponding operation;

a module (it is taught as a digital control unit 103) to detect that said IC card has been accessed; and

a module (it is taught as a program control unit 111) to perform a predetermined corresponding operation in the case where the change that occurs in the contents of the IC card as the result of said access satisfies said conditions for the corresponding operation (section 0074 to section 0077).

Regarding claim 2, Arisawa teaches said access detection module checks the card information of said IC card at a predetermined timing thereby to detect the access to said IC card (it is taught as the digital control unit 103 totally controls processing on received data or data to be transmitted or other operations of the IC card, section 0063, first three lines).

Regarding claim 3, Arisawa teaches said access detection module detects the communication between said IC card and an external device (section 0064, first two lines)

Regarding claim 4, Arisawa teaches said access corresponding operation module transmits and receives data between said IC card and a management apparatus for executing a predetermined process (section 0074).

Regarding claim 5, Arisawa teaches said access corresponding operation module can set the conditions for the corresponding operation including the change amount and the change item of the card information on the one hand and a

particular corresponding operation on the other hand (section 0075 to section 0077).

Regarding claim 6, Arisawa teaches management apparatus comprising:

a portable terminal identifying module to receive the card information from a non-contact IC card processing unit having a module to communicate with an IC card without contact (Fig.1, section 0050) and to acquire the card information including the IC card identification information and the outstanding value information thereby to identify the portable terminal having the IC card based on said IC card identification information(section 0051, it is taught as billing and authentication checks);

a memory module (a memory 104 as shown in Fig.5) to store the conditions for the corresponding operation;

a module (it is taught as a digital control unit 103) to communicate with said portable terminal;

an information transmission determining module (it is taught as a program control unit 111) to determine whether the predetermined information for charging against the outstanding SF value is to be transmitted to the portable terminal identified by said portable terminal identification module in the case where the contents of said card information satisfy said conditions for the corresponding operation (section 0074 to section 0077); and

a module (it is taught as the IC card 100, section 0077, last two line) to transmit said information determined by said information transmission determining module.

Regarding claim 8, Arisawa teaches a portable terminal comprising an information receiving module to receive said predetermined information transmitted by the management apparatus (it is taught as a card reading and writing apparatus is installed on the ticket checker to access an IC card from the portable terminal of a user walking through the ticket gate to read and write data; section 0050) and a corresponding operation module to perform a predetermined corresponding operation in accordance with said predetermined information received by said information receiving module (section 0051).

Regarding claim 9, Arisawa teaches said information transmission module transmits selected one of the information for starting the program to charge the value at said portable terminal, the information for renewal of the validity period of the commuter pass at the portable terminal and the information for starting the program to renew the validity period of the commuter pass at the portable terminal (it is taught as the card reading and writing apparatus can transmit data to the IC card, the data to be transmitted includes a secret personal number, amount information etc. section 0058).

Regarding claim 10, Arisawa teaches said corresponding operation module performs selected one of the operation of charging the SF value and the operation of renewing the validity period of the commuter pass (it is taught as the IC card has a

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function for varying the load according to data to be returned to the card reading and writing apparatus).

Regarding claim 11, Arisawa teaches said access corresponding operation module identifies the user as required (section 0051).

Regarding claim 12, Arisawa teaches the user is identified only after a predetermined operation is performed a specified number of times or only when the operation of specific contents is performed (section 0051).

Regarding claim 13, Arisawa teaches the user is identified by selected one of an ID, a password, fingerprints, an iris, a voice, face features and any combination thereof (section 0058).

Regarding claim 14, Arisawa teaches an IC card management method for managing an IC card mounted in a portable terminal based on the card information of said IC card, comprising the steps of:

acquiring the card information of said IC card from said portable terminal (it is taught as amount information such as prepaid electronic money or electronic ticketing within the portable terminal; section 0052, last two lines and section 0053 to section 0054); and

comparing said acquired card information (information in the IC card) with predetermined conditions for the corresponding operation (ticket checker) and in the case where said card information satisfies said conditions for the corresponding operation, causes said portable terminal to perform the operation corresponding to said card information (section 0050).

Regarding claim 15, Arisawa teaches said card information is the outstanding SF value acquired from said portable terminal through a ticket checking machine, and wherein said corresponding operation is to charge the SF value on said IC card (Fig.1 and section 0050-0051).

Regarding claim 16, Arisawa teaches said card information is the validity period of a commuter pass acquired from said portable terminal through a ticket checking machine, and wherein said corresponding operation is to notify said validity period of said commuter pass in said portable terminal (it is taught as allowing the user to walk through the ticket gate after billing and authentication checks, section 0051).

Allowable Subject Matter

7. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Doi et al

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9. When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111 (c).

10. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Song whose telephone number is 571-272-4213. The examiner can normally be reached on 7:30-5:30 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jasmine Song

Patent Examiner

October 27, 2006